



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,788	07/25/2001	Dietmar Huglin	HP/2-21868/US/A/PCT	3541

324 7590 11/26/2002

CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
540 WHITE PLAINS RD
P O BOX 2005
TARRYTOWN, NY 10591-9005

EXAMINER

BADIO, BARBARA P

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 11/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,788

Applicant(s)

HUGLIN ET AL.

Examiner

Barbara P. Badio, Ph.D.

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) 18, 19, 27, 28 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 20-26 and 29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

First Office Action on the Merits***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 16-26 and 29 (embracing body care compositions comprising benzotriazoles of formula 1 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the triazines and benzotriazoles are disclosed as interchangeable members of a Markush group and they have the same mode of operation, function and effects and, thus, should be precluded from restriction. This is not found persuasive because the claimed invention relates to a multitude of inventions, which are not linked by a single inventive concept as required under PCT rules. In addition, a search of the entire application would require a number of different search strategies because of the differences in structure of the compounds and the uses thereof.

The requirement is still deemed proper and is therefore made **FINAL**.

2. Based on applicant's election of Group I and the species of formula (53), claims 18, 19, 27, 28 and 30 stand withdrawn from further consideration as being drawn to a non-elected invention. Claims 16, 17, 20-26 and 29 will be examined to the extent they read on the elected invention and obvious variants thereof (i.e., compounds of formula (1) wherein m is one and R₂ is alkyl).

Specification

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Objections

4. Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The instant claim, unlike claim 16, recites (a) compounds of formula (3) wherein R_2 is not fixed in the ortho position to the hydroxyl group and (b) R_2 is SO_3M . Thus, the instant claim does not limit the subject matter of parent claim 16.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16, 20-26 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, (a) the recitation of the term "preferably" in the definition of R_3 renders the claim indefinite because it is unclear whether the limitations following

the phrase are part of the claimed invention and (b) the structure of formula (1a) is incomplete (see the SO₃ group attached to the structure).

Claim 26 recites the limitation "cosmetic" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 16, 17, 20, 21, 24, 26 and 29 are rejected under 35 U.S.C. 102(a) as being anticipated by Luther et al. ('370).

Luther et al. teach the use of benzotriazole for the protection of human hair from the harmful effects of UV radiation (see the entire article, especially, col. 7, lines 27-33; col. 9-10, Table 1, compound 102). The reference teaches formulations such as shampoo, lotion, gel, dyes etc. and the incorporation of other active ingredients such as vitamin E (see especially col. 8, lines 24-50 and example 2). The compositions taught by the reference are encompassed by the instant claims.

Art Unit: 1616

9. Claims 16, 20-23, 25, 26 and 29 rejected under 35 U.S.C. 102(b) as being anticipated by Dumler et al. (GB 2,286,774).

Dumler et al. teach UV absorbers, such as triazoles, suitable for use in pharmaceutical or cosmetic preparations, such as sunscreens (see the entire article, especially page 4, formula (4); page 9, compounds 25 and 26; page 12, paragraphs 1-3). The compositions taught by the reference are encompassed by the instant claims.

10. Claims 16, 20-22, 24, 25 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Strobel ('132).

Strobel teaches the use of isomeric mixtures of 2-(5-dodecyl-2-hydroxyphenyl)benzotriazole as stabilizers for heat and light sensitive materials such as sunscreens (see the entire article, especially col. 2, lines 13-63; col. 7, lines 39-58; col. 8, lines 5-54; col. 13, example X). The compositions taught by the reference are encompassed by the instant claims.

Telephone Inquiry


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax

Art Unit: 1616

phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Barbara P. Badio, Ph.D.
Primary Examiner
Art Unit 1616

BB
November 25, 2002